

### **REMARKS**

By this Amendment, Applicants have amended the specification, amended claims 1, 6, 22, 24, 25, 27, 29, 30, and 32, and canceled claim 9 without prejudice or disclaimer. Claims 1-8 and 10-37 remain pending.

In the Office Action, the Examiner objected to the specification for referring to attorney docket numbers of pending patent applications or issued patents instead of their corresponding patent application numbers or issued patent numbers; rejected claims 1-12, 14-23, 26-28, and 31-33 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,571,003 ("*Hillebrand*"); and rejected claims 13, 24, 25, 29, 30, and 34-37 under 35 U.S.C. § 103(a) as unpatentable over *Hillebrand*.

### **OBJECTION TO SPECIFICATION**

Applicants have amended the specification to refer to the patent application numbers of the documents cited in the specification, instead of their attorney docket numbers. Accordingly, the objection to the specification for referring to attorney docket numbers should be withdrawn.

### **REJECTION OF CLAIMS 1-8, 10-12, 14-23, 26-28, AND 31-33 UNDER 35 U.S.C. § 102(e)**

Applicants respectfully request that the section 102(e) rejection of claims 1-8, 10-12, 14-23, 26-28, and 31-33 be withdrawn.

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim[s]." See

M.P.E.P. § 2131 (8th Ed. May 2004). Finally, “[t]he elements must be arranged as required by the claim.” *Id.*

For independent claim 1, *Hillebrand* fails to teach at least extracting from at least one image at least one representation of at least one skin condition, “wherein the extracted representation includes a skin condition image devoid of substantially all facial features other than the at least one skin condition,” and “displaying the skin condition image such that the subject is substantially unidentifiable,” as recited in amended claim 1. In contrast, *Hillebrand* discloses an apparatus displaying defects on a subject's digital image (Figs. 11-14, col. 11, lines 10-13) and maintaining the subject substantially identifiable in the digital image.

For independent claim 6, *Hillebrand* fails to teach at least extracting at least one representation of at least one skin condition from at least one image of at least one portion of a subject's facial skin, “wherein the at least one extracted representation includes a skin condition image devoid of substantially all facial features other than the visible wrinkles,” and “displaying the skin condition image such that the subject is substantially unidentifiable,” as recited in claim 6. In contrast and as discussed above, *Hillebrand* discloses an apparatus displaying defects on a subject's digital image and keeping the subject substantially identifiable in the digital image.

For independent claim 22, *Hillebrand* fails to teach at least extracting at least one representation of at least one skin condition from at least one image of at least one portion of a subject's facial skin, “wherein the extracting occurs to an extent that the subject is anonymous when the representation is viewed,” and “displaying the representation such that the subject is anonymous,” as recited in claim 22. In contrast

and as discussed above, *Hillebrand* discloses an apparatus displaying defects on a subject's digital image and the subject is not anonymous in the digital image.

For independent claim 27, *Hillebrand* fails to teach each and every element recited in the claim for reasons similar to those discussed above for claim 1.

For independent claim 32, *Hillebrand* fails to teach at least a "processor configured" to identify in an image at least one skin condition and "for extracting from the image at least one representation of the at least one skin condition to thereby protect the subject's identity," as recited in claim 32. In contrast and as discussed above, *Hillebrand* discloses an apparatus displaying defects on a subject's digital image without protecting the subject's identity.

For independent claim 33, *Hillebrand* fails to teach at least providing "software for modifying" at least one image "to remove at least some information unrelated to skin analysis, thereby protecting the subject's identity during transmission," as recited in the claim. *Hillebrand* also fails to teach at least "performing a skin analysis on the modified image," as recited in the claim. In contrast, *Hillebrand* does not protect the subject's identity during transmission and does not perform a skin analysis on a modified image.

Accordingly, for at least the above reasons, the rejection of independent claims 1, 6, 22, 27, 32, and 33 under 35 U.S.C. § 102(e) as anticipated by *Hillebrand* should be withdrawn. The rejection of dependent claims 2-5, 7, 8, 10-12, 14-21, 23, 26, 28, and 31 under 35 U.S.C. § 102(e) as anticipated by *Hillebrand* should also be withdrawn at least by virtue of the dependence of those claims upon allowable claims 1 and 27, respectively.

**REJECTION OF CLAIMS 13, 24, 25, 29, 30, AND 34-37 UNDER 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 13, 24, 25, 29, 30, and 34-37 under 35 U.S.C. § 103(a) as unpatentable over *Hillebrand* because *prima facie* obviousness has not been established with respect to these claims.

To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143.

For claim 13, the Examiner admits, on page 7 of the Office Action, that *Hillebrand* fails to teach or suggest storing includes saving the at least one representation at an address separate from an address of the at least one image, as recited in the claim. The Examiner attempts to overcome this deficiency in *Hillebrand* through Official Notice. Applicants challenge the Examiner’s Official Notice.

Official Notice is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. The features recited in claim 13 were not unquestionably well-known and the Examiner has failed to demonstrate the contrary. Alleging that “storing different data information . . . at separate addresses is a well known methodology routinely

implemented in image processing as an obvious procedure” does not, in and of itself, establish that such subject matter was in fact well known. OA at page 7. Moreover, the Examiner’s allegation that it “is a well known methodology” does not establish that the “storing” feature of claim 13 was unquestionably well-known.

Additionally, claim 13 depends upon claim 1. As discussed above, *Hillebrand* fails to teach each and every element recited in claim 1. Consequently, *Hillebrand* also fails to teach each and every element in dependent claim 13 and the Examiner’s Official Notice in the rejection of claim 13 does not overcome this deficiency.

For claim 24, *Hillebrand* fails to teach or suggest receiving at least one image of at least one portion of a subject’s facial skin, “wherein skin in the received image is covered with powder to facilitate extracting” at least one representation and “extracting from the at least one image at least one representation of the at least one skin condition,” as recited in the claim. The Examiner attempts to overcome this deficiency through Official Notice. OA at page 8. Applicants challenge the Examiner’s Official Notice.

The features recited in claim 24 were not unquestionably well-known and the Examiner has failed to demonstrate the contrary. Alleging that “it is well known in the art to cover . . . with powder to facilitate extracting . . . the image representation because it will reduce the effects of light variations to enable capturing an enhanced image” does not, in and of itself, establish that such subject matter was in fact well known. OA at page 8. Moreover, the Examiner’s allegation that it is “well known” does not establish that the “covered with powder to facilitate extracting” feature of claim 24 was unquestionably well-known. Finally, even if it were well known “to cover . . . with

powder to facilitate extracting . . . the image representation because it will reduce the effects of light variations to enable capturing an enhanced image,” this subject matter does not constitute “extracting from the at least one image at least one representation of the at least one skin condition..., wherein the skin in the received image is covered with powder to facilitate extracting the at least one representation,” as recited in claim 24.

For claim 25, *Hillebrand* fails to teach or suggest receiving at least one image of at least one portion of a subject’s facial skin, “wherein skin in the received image is illuminated with a Woods lamp to facilitate extracting” at least one representation, and “extracting from the at least one image at least one representation of the at least one skin condition,” as recited in the claim. The Examiner attempts to overcome this deficiency through Official Notice. OA at page 8. Applicants challenge the Examiner’s Official Notice.

The features recited in claim 25 were not unquestionably well-known and the Examiner has failed to demonstrate the contrary. Alleging that “it is well known in the art to illuminate the skin with a Woods lamp . . . to facilitate extracting the at least one representation associated with the skin condition” does not, in and of itself, establish that such subject matter was in fact well known. OA at page 8. Moreover, the Examiner’s allegation that it is “well known” does not establish that the “Woods lamp” feature of claim 25 was unquestionably well-known.

For claims 29 and 30, the section 103(a) rejection of those claims should be withdrawn for reasons similar to the rejection of claims 24 and 25 and Official Notice applied to the rejection of those claims is improper for reasons similar to those

discussed in connection with the rejection of claims 24 and 25, respectively. (Applicants note that claims 29 and 30 have different scopes from claims 24 and 25.)

Furthermore, regarding Official Notice, M.P.E.P. § 2144.03 makes clear “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). In addition, M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted).

M.P.E.P. § 2144.03(B) states that “if Official Notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable.” Specifically, M.P.E.P. § 2144.03(B) states that:

[If] . . . official notice has been taken of a fact that is asserted to be “common knowledge” without specific reliance on documentary evidence . . . , the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. . . The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made. (internal citations omitted).

The Office Action failed to provide substantial evidence on the record to support the taking of the Official Notices for claims 13, 24, 25, 29, and 30. The Examiner merely makes conclusory statements that certain subject matter was well-known, without supporting documentary evidence and without a clear and unmistakable technical line of reasoning supporting a decision to take the Official Notices.

Applicants respectfully request that the Examiner withdraw the rejection of claims 13, 24, 25, 29, and 30. Applicants also request that, to the extent the Examiner is relying on personal knowledge in alleging that certain features were well-known, the Examiner provide an affidavit so that Applicants will be able to respond in kind. See M.P.E.P. § 2144.03.

Additionally, for claims 13, 24, 25, 29, and 30, *prima facie* obviousness has not been established at least because the requisite motivation to modify *Hillebrand* with Official Notice is lacking. The Office Action does not provide any suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference in a manner resulting in the claimed invention.

Likewise, for claims 34-37, the Office Action has not set forth a *prima facie* case of obviousness because the Examiner has failed to provide a sufficient motivation or suggestion for modifying *Hillebrand* to perform a hair analysis or nail analysis. On page 8 of the Office Action, the Examiner alleges that using the disclosure of *Hillebrand* with hair or nails is nothing more than a "design-like feature." The M.P.E.P. states, however, a suggestion or motivation to modify a reference must either be in the reference or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. § 2143. The Examiner has not provided any evidence from either the reference or in the knowledge generally available to modify *Hillebrand* for hair analysis or nail analysis.

Accordingly, for at least the above reasons, the rejection of claims 13, 24, 25, 29, 30, and 34-37 under 35 U.S.C. § 103(a) should be withdrawn.



**CONCLUSION**

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

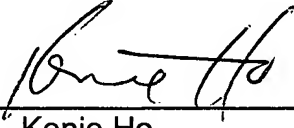
Applicants note that the Office Action contains numerous statements reflecting apparent assertions concerning the related art and claims. Regardless of whether any such statement is addressed specifically herein, Applicants decline to automatically subscribe to any assertion and/or characterization set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 20, 2005

By:   
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